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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,899	05/10/1999	GORAN MARNFELDT	06275/184001	1423

7590 07/29/2002

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ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 07/29/2002

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 13

Application Number: 09297899

Filing Date: May 10, 1999

Appellant(s): Goran Marnfeldt et al.

Mr. William E. Booth

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 April 02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims stand or fall together as set forth by Appellant.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5687710	Ambrosia et al.	11-1997
5505195	Wolf et al.	04-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-5 & 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambrosio et al (5687710).

In regards to claims 1 & 16, Ambrosio discloses an inhaler for delivering medicament (see fig 1-4), with a housing member (120/380/440/320) extending along a vertical (longitudinal?) axis and having an opening (see the opening at the 440 portion which is adapted to engage a user's nares) an inhalation channel (64) that is within the housing member and extending substantially parallel to said vertical axis said inhalation channel member having an inlet portion (vic of elements 90/100 & the metering plate 180), middle portion (portion of 22 between the inlet and outlet portions) and outlet portion (where 22 terminates into the interior of 380) , a rotatable dosing unit (22), a dosing element (182) for providing a dose of medicament to the inhalation channel (64), a dose counting unit (580), comprised of a display (330), which is aligned in an opening of the housing which displays usage of the inhaler and which may be outfitted with an electrical circuit (col. 25 lines 23-29) for counting each dose of medicament provided to the inhalation channel and drive the display so as to provide an indication as to the usage of the inhaler, the electrical circuit would include be understood to include a conventional switch arrangement comprised of contact elements arranged to have a first open position and a second closed position, when a dose of

medicament is provided to the channel, a rotatable member (590) connected to the dosing unit, which is a cam (a rotating or sliding piece in a mechanical linkage) having a camming surface (the surfaces of the various gear teeth 602/604/606), configured to rotate the dosing unit to provide a dose of medicament to the inhalation channel, where the cam will be in physical contact with a contact element and is capable of causing movement of a contact element respective of the at least one switch from an open position to a closed position (see figs 67-82 & 93-104) or where the contact element is locate-able within the path of travel of the cam for first and second position displacement, but Ambrosio does not disclose the display being "electronic" and connected to the electric circuit and the electric counting mechanism as set forth by Appellant. However, Wolf discloses such electronic display (1035). The references are analogous since they are from the same field of endeavor, the inhaler arts. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to have taken the features of Wolf and used them with the device of Ambrosio when using an electronic switch. The suggestion/motivation for doing so would have been to since Wolf discloses a electronic display for displaying the count of doses counted by an electronic switch on an inhaler, and since Ambrosio discloses the use of an electronic dose counting means with its inhaler (col. 25, lines 23-28). Therefore it would have been obvious to combine the references to obtain the instant application's invention.

In regards to claim 2, the device suggested by Ambrosio & Wolf discloses the use of two switches (435 & 436 Wolf & Ambrosio notes that plural contact elements can be used).

Furthermore, it is noted that Appellant's specification does not set forth this duplication of a known part for a known purpose, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of this duplication of a known part for a known purpose to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claims 3 & 4, the reference noted above substantially disclose the claimed invention except for the use of a plurality of dosing elements/cams & cam surfaces, i.e. the duplication of a known part for a known purpose.

It is noted that Appellant's specification does not set forth this duplication of a known part for a known purpose, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of this duplication of a known part for a known purpose to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

Also in regards to claims 3 & 4, the reference noted above substantially disclose the claimed invention except for the maintenance of a constant angular spacing.

It is noted that Appellant's specification does not set forth this constant angular spacing, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of a constant angular spacing of the cams/cam surfaces to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claim 5, the device suggested by Ambrosio & Wolf discloses the rotational off setting of switches (see e.g. 435 & 436, figs 4a & 4b).

In regards to claims 7 & 8, the reference noted above substantially disclose the claimed invention except for the use of a resilient biasing arm with a first portion for riding on the cam surface and a second portion for providing a contact means to facilitate lateral movement.

It is noted that Appellant's specification does not set forth this arrangement/feature, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of this arrangement/feature to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather that to constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

In regards to claim 9, the reference noted above substantially disclose the claimed invention except for the use of a bend in a contact arm.

It is noted that Appellant's specification does not set forth this feature, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of a bent contact arm to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather that to constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

In regards to claim 10, Ambrosio substantially discloses the instant application's invention to include the use of a shaft (188) with a surface (190) providing an external/internal spline & another element (218) with surface (222) providing another external/internal spline so that when engaged they facilitate the dosing unit and the rotatable member to be rotated co-commitment, however these elements are not directly part of the dosing unit & rotatable member, as set forth by Appellant, i.e. a reversal or rearrangement of known parts for a known purpose.

It is noted that Appellant's specification does not set forth this reversal or rearrangement of known parts for a known purpose, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art.

Accordingly, the examiner considers the selection of this reversal or rearrangement of known parts for a known purpose to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claims 11-13, Wolf discloses the display as displaying doses used, doses remaining and is fully capable of being programmed to alternatively display dosage information (col. 13 lines 46-67).

In regards to claim 14, Wolf discloses the display as being an LCD display (1035, col. 13 lie 52).

In regards to claim 15, Ambrosio & wolf discloses a grip so the user may grip the device and rotate it to actuate the dosing mechanism (110 of Wolf & 320 of Ambrosio).

(11) Response to Argument

In regards's to Appellant's argument that usage of the term "conventional" somehow is an alteration of the prior art teaching, Appellant is in error. The use of the term conventional by the examiner in the office action is followed by text/language that parallels that of the prior art, i.e. the use of contacts in the base or other location of the device at some point in the dose loading operation (note Col. 25, lines 25-27). Thus the examiner has added noting to the actual teaching. It is noted that Appellant's switch is a circuit with contact elements, just as disclosed by the prior art teaching. Therefore, this argument in no way shape or form points to any deviation, difference or distinction between the prior art and the instant claim language, nor has the use of the term "conventional" caused a misapplication of the prior art to the claim language since the examiner clearly set forth this language to mean nothing more than what the prior art set forth. Because Appellant's claim language of a camming surface and a cam did not add any additional structure over that already present in the prior art (note that Ambrosio et al is an elongated cylindrical device with internal parts that bias about a central axis relative to each other, such elements meet the broad language of a cam and their surfaces would thus be camming surfaces, and that the teaching discloses placement of the contacts in such a way as to be actuated during operation of the device, i.e. when it cams/rotates.) The rejection under 35 USC 103(a) is an inherent acknowledges the prior art did not explicitly disclosed every scintilla of Appellant's contact placement, but that appellant's placement of the contacts on a camming surface of a camming inhaler to facilitate dose counting would be obvious in light of the level of ordinary skill in the art as evidenced by the prior art.

Furthermore, disclosures are written to the level of ordinary skill in the art. The patentee of Ambrosio set forth the use of contact elements on a camming inhaler and stating that the contacts should be placed in a manner to facilitate contact during the device's operation. Inferential from this is that placement on the camming elements of the device would be appreciated by one of ordinary skill in the art, because not placing on the camming/operation elements would be pointless since it would not track dosing of facilitate the making and breaking of contact, i.e. actuation/camming of the device.

In regards to the citation of magnetic switch of Wolf, the Examiner fails to see the relevance of pointing this out. The Wolf disclosure was relied upon in rejecting Appellant's independent claims for use of an electronic display, not Wolf's switch. The examiner acknowledges that Wolf was used in an obviousness type combination rejection to teach the use of an electronic display, e.g. LCD or LCD, however use of a mechanical display in connection to/combination with a electrical switch is not an impossibility as appellant attempts to assert, the concept of "electro-mechanical" devices does exist. Furthermore, use of the term "electrical counter" could inherently include the sub-component of an electrical display. (Please note that the mere window 330 permits one to see numbers to determine the dose count.)

In regards to Ambrosia teaching that a mechanical counter is preferred, the examiner concurs, but the reference/record/evidence is to be considered as a whole and not just dissected and picked over to find those portions that support one's position and to ignore those portions that take away from one's position. When viewing Ambrosia as a whole, one of ordinary skill in the art would appreciate just as the reference states in col. 25 lines 23-25 and the examiner quotes "Many types of mechanical and electrical counters are useful. A digital electronic counter can be disposed within the base or other area of the

device." Thus Ambrosia while citing a preference for a mechanical counter, also teaches that electrical counters may be used and that mechanical and electrical counters are equally useful in such a device, i.e. interchangeable equivalents. Thus Appellant's argument is in error and at best points to a difference without a distinction, because the claim language would fall within the scope of the prior art teachings as understood by one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joseph F. Weiss, Jr.

July 23, 2002

Conferees

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PRIMARY EXAMINER

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